

REMARKS

Claims 1-20 were pending in the subject application and have been examined on the merits. Claims 1-20 have been cancelled and have been substituted with new claim 21-40. No new matter has been added.

Support for new claims 21-40 can be found in original claims 1-20 and in the Specification at page 5 lines 1-10.

In the Office Action, claims 1-20 were objected to for having the lines crowded too closely together, making reading difficult. Claims 1-20 have been substituted with new claims 21-40 with lines double spaced as requested.

Applicants' Claims 1-20 Are Non-Obvious Over The Cited Prior Art

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Chan (U.S. Patent 6,342,952, hereinafter “Chan”).

Applicants respectfully traverse this rejection.

To establish a *prima facie* case of obviousness of a claimed invention, three basic criteria must be met:

- 1) There must be some suggestion or motivation, either in the reference itself, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference;
- 2) There must be a reasonable expectation of success;
- 3) The prior art reference (or references combined) must teach or suggest all of the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art.

MPEP § 706.02(j).

Applicants respectfully submit that the Examiner's modification of Chan as proposed fails to meet the criteria (1), (2) and (3) to establish a *prima facie* case of obviousness, thus withdrawal of this rejection is respectfully requested.

The presently claimed invention is directed to a method for controlling metamerism caused by inks used for coloring different types of colored materials (e.g., page 5, lines 10-14). One application of the presently claimed invention is a paper label on a plastic bottle which is to be colored a particular shade of blue, while the plastic bottle cap for a bottle is to be colored the same shade of blue (e.g., page 5, lines 7-10).

On the contrary, Chan teaches and discloses a method to solve the problem of international companies having to rely on local businesses for printing labels and product literature. The labels, product brochures, or other printed articles may then have color variations from location to location or even for different printing runs because of error introduced by subjective color matching methods, by slightly different color standards, by different equipment and different printing conditions and so on (e.g., col. 1, lines 22-33).

In other words, Chan does not teach or suggest the method of the presently claimed invention, e.g., a method for controlling metamerism by providing a plurality of formulas that are suitable for producing a color for at least two different types of colored materials. That is, Chan does not disclose all of the claimed limitations.

Furthermore, as Chan does not teach or suggest how to solve the problem of metamerism to obtain the exact same color in two different types of colored material, one skilled in the art would not be motivated to make the modifications cited by the Examiner.

Finally, as Chan fails to disclose a critical element of the claimed invention (e.g., the application of the exact same color in two different types of colored material), a skilled artisan would have no expectation of success, even if, *arguendo*, the modification of Chan was proper.

In sum, in the absence of (a) a disclosure of all of the claimed limitations in the cited reference; (b) motivation to modify the cited reference to achieve the claimed invention; and (c) a reasonable expectation of success, Applicants respectfully submit that there is not a *prima facie* case of obviousness.

As such, Chan does not render obvious claims 21-40 and withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

In light of the foregoing, the application is now believed to be in proper condition for allowance and a Notice to that effect is respectfully requested. If this *Response To Office Action* does not otherwise result in the issue of such Notice, the Examiner is respectfully invited to contact the Applicants' undersigned counsel for an interview.

No extra fee is believed due. However, if any additional fees are necessary, the Director is hereby authorized to charge such fees or credit any overpayment to Deposit Account No. 50-0540.

Respectfully submitted,

Date: September 27, 2006

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